

U.S. Application No. 10/651,428, filed August 29, 2003
Attorney Docket No. 17405US04
Amendment dated March 19, 2007
In Response to Office Action mailed October 19, 2006

REMARKS

Claims 1-20 are pending in the present application. Claims 1-20 were rejected. Claims 3 and 4 were amended.

Claims 10, 11 and 14-17 were improperly rejected. It appears that the elements as set forth in claims 10, 11 and 14-17 were considered only in a vacuum as opposed in view of the independent claims from which they depend.

Claims 10, 14 and 15 are part of the independent claim set based on independent claim 3. Claims 11, 16 and 17 are part of the independent claim set based on independent claim 4. Yet, solely due to the error of the USPTO, claims 10, 11 and 14-17 were improperly and incorrectly rejected as being part of the independent claim set based on independent claim 1.

Since the rejections are logically improper and the improperness is solely due to USPTO error, it is respectfully submitted that a proper *prima facie* case of obviousness be presented, for the first time, in a subsequent Office Action, if necessary.

The attention of the Examiner is respectfully directed to M.P.E.P. § 2142 which states that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” M.P.E.P. § 2142 at 2100-125 (Rev. 5, Aug. 2006).

Claims 1, 2 and 7-17 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,349,220 B1 (“Prior”). Applicant respectfully traverses the rejection as set forth below.

As discussed above, claims 10, 11 and 14-17 were improperly rejected under the presumably mistaken assumption that claims 10, 11 and 14-17 depended from claim 1. Thus, the proper rejection with respect to the independent claim set based on independent claim 1 is the following: claims 1, 2, 7-9, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,349,220 B1 (“Prior”)

To maintain an obviousness rejection, Prior must teach each and every element as set forth in the claims. Prior does not teach each and every element as set forth in the claims. For

example, claim 1 recites “displaying a plurality of recording modes, each of the plurality of recording modes for recording a different set of data frames exchanged between the mobile set and a second device during a phone call”. As the Office Action admits, Prior does not teach displaying a plurality of recording modes. In fact, Prior teaches a “dedicated function” for single key 26. Prior teaches that “the user could press the key once to activate recording and press it a second time to end recording”. There is no display of a plurality of recording modes because there are no recording modes, merely a single key 26 that can start or stop recording.

The Office Action appears to allege that Prior does teach a touchpad. However, such a point is not relevant. The relevant point is whether Prior teaches “a plurality of recording modes” as set forth in claim 1. Prior does not teach a plurality of recording modes. Prior teaches a dedicated single key 26 that “the user could press the key once to activate recording and press it a second time to end recording”. There is no hint of selectivity from dedicated single key 26. Even, in the embodiment as a softkey, single key 26 is has a passive role in view of the circumstances (e.g., whether a call is in progress or not). See, e.g., Prior at col. 4, lines 33-46.

In addition, claim 1 recites “data frames”. Prior does not even mention anywhere “frames” or, in particular, “data frames”. If Prior does not even mention “frames” or “data frames”, then how can Prior teach “frames” or “data frames” as set forth in claim 1. It is respectfully submitted that Prior’s silence teaches nothing.

Claim 1 recites “recording a set of data frames identified by a selected recording mode”. Applicant respectfully submits that Prior does not teach “recording a set of data frames identified by a selected recording mode” since (1) Prior does not teach selecting a recording mode as set forth in claim 1; (2) Prior does not record “identified” data frames as set forth in claim 1; and (3) Prior does not teach “frames” and “data frames” as set forth in claim 1.

Applicant respectfully submits that the analysis on page 3 of the Office Action with respect to claim 1 does not present a *prima facie* case of obviousness with respect to each and every element as set forth in claim 1. The attention of the Examiner is respectfully directed to M.P.E.P. § 2142 which states that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case,

the applicant is under no obligation to submit evidence of nonobviousness.” M.P.E.P. § 2142 at 2100-125 (Rev. 5, Aug. 2006).

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claim 1 and its rejected dependent claims (i.e., claims 2, 7-9, 12 and 13).

Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being obvious over Prior in view of U.S. Patent No. 6,233,320 B1 (“Haimi-Cohen”). Applicant respectfully traverses the rejection as set forth below.

Claims 3 and 4 have been amended to expedite prosecution and to further clarify the phrase “data content analysis”.

Claims 3 and 4 recite “wherein the uplink and downlink data frames are selectively recorded based on data content analysis performed by the mobile set of each uplink and downlink data frame”.

Applicant respectfully submits that neither Prior nor Haimi-Cohen, individually or combined, teaches at least these elements. In fact, Applicant takes exception to the Office Action’s characterization of Prior at page 4. The Office Action alleges that Prior teaches “utilizing a dedicated function key to record voice conversation for a period, just the user’s voice or just the other party during a phone call”. Respectfully, Prior does not teach such a selection of recordings. Instead, Prior teaches a dedicated single key 26 that “the user could press the key once to activate recording and press it a second time to end recording”. There is no hint of selectivity from dedicated single key 26. Even, in the embodiment as a softkey, single key 26 is has a passive role in view of the circumstances (e.g., whether a call is in progress or not). See, e.g., Prior at col. 4, lines 33-46.

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claims 3-5.

Claims 6 and 20 depend from claim 4. Claim 19 depends from claim 3. Since the rejection of claims 6, 19 and 20 are based, in part, on the combination of Prior and Haimi-Cohen, it is believed that claims 6, 19 and 20 are allowable for at least the above reasons with respect to claims 3 and 4.

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claims 6, 19 and 20.

Claim 18 stands rejected under 35 U.S.C. § 112, ¶ 1, as not being enabling. Claim 18 depends from claim 3. Claim 18 recites “[t]he method of claim 3, wherein data content analysis includes a determination of data content level”.

Applicant respectfully submits that the Office Action discussion on page 2 appears to be confusing enablement of the elements as set forth in claim 18 with enablement of a merely exemplary embodiment described in the specification. The claims are generally of a broader scope than the embodiments described in the specification. In other words, the claimed invention as set forth in claim 18 is not limited only to a particular embodiment or embodiments described in the specification.

The issue here under 35 U.S.C. § 112, ¶ 1, is whether one of ordinary skill in the art would understand that data content analysis includes a determination of data content level. It is respectfully submitted that each and every element as set forth in claim 18 is understood by one of ordinary skill in the art. The Office Action at page 2 alleges that “data content” is a phrase that is unknown to one of ordinary skill in the art. Applicant disagrees that one of ordinary skill in the art would not understand “data content”. Furthermore, the Office Action is believed to be in error by alleging that “data content analysis” or “determination” or “data content level” are words never before understood by one of ordinary skill in the art. Applicant respectfully submits that the Office Action underestimates the abilities and understanding in view of the elements as set forth in claim 18 of one of ordinary skill in the art.

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 112, ¶ 1, be withdrawn with respect to claim 18.

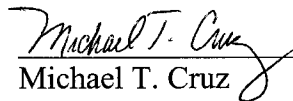
In view of at least the foregoing, it is respectfully submitted that the pending claims 1-20 are in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

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The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: March 19, 2007

Respectfully submitted,



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